MTS-3506US

Application No.: 10/500,274
Amendment Dated: January 22, 2009
Reply to Office Action of: September 24, 2008

#### Remarks/Arguments:

Claims 3-9 and 14 are pending in the above-identified application for consideration. By the present Amendment, claims 3-9 are amended; claims 1, 2, 12 and 13 are cancelled; and new claim 14 is presented for consideration. Claims 10 and 11 have been previously withdrawn from consideration.

#### Rejections of the Claims Under 35 U.S.C. § 112, First Paragraph

Pending claims 3-9 are rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. Applicants respectfully disagree but amend the claims to expedite prosecution. In particular, Applicants amend pending claims 3-9 to remove recitations relating to a "computer processor" and "software instructions." Applicants reserve their right to present such limitations in the future and argue for their compliance with the written description requirement. Withdrawal of the rejections and favorable reconsideration of the claims are respectfully requested.

### Rejections of Claims 1, 3, and 12 Under 35 U.S.C. § 103(a)

Claims 1, 3, and 12 are rejected under 35 U.S.C. § 103(a) for being unpatentable over WIPO International Publication No. WO 01/92050 of Yamanashi, U.S. Patent No. 5,989,739 to Zur Megede et al. ("Zur Megede"), U.S. Patent No. 6,797,418 to Nomura et al. ("Nomura"), and U.S. Application Publication No. 2002/0051899 of Keskula et al. ("Keskula"). By the present Amendment, Applicants amend claim 3 and cancel claims 1 and 12 to expedite prosecution. For the reasons discussed below, Applicants respectfully assert that claim 3 is not obvious in view of Yamanashi, Zur Megede, Nomura, and Keskula.

In particular, Applicants respectfully assert that neither Yamanashi, nor Zur Megede, nor Nomura, nor Keskula, nor their combination discloses or suggests the following features of claim 3:

... the electric power generation instructing means configured to decrease the electric power generated by the fuel cell at a rate depending on a change of the temperature of the fuel processor, wherein:

the electric power generation instructing means are configured to decrease the generated electric power at a first rate within a predetermined first limit while the temperature of the fuel processor is rising and at a second rate having no predetermined limit while the temperature of the fuel processor is not rising.

These features can be found in the originally filed application at page 17, line 10 page 19, line 8 and originally filed claims 1 and 2. No new matter has been added.

 Yamanashi Does not Disclose the Configuration of the "Electric Power Generation Instructing Means" Recited in Claim 3

The above-identified application describes various algorithms which an electric power generation instructing means is **configured to** perform. (See, e.g., Application, page 16, lines 12-15; page 22, lines 10-13; page 29, lines 17-20; and Figs. 2, 4, and 6.) Applicants respectfully assert that the control unit 300 of Yamanashi does not disclose or suggest all of the above-quoted features of claim 3 relating to the "electric power generation instructing means."

In a first embodiment of the fuel cell system of Yamanashi, a control unit 300 receives a signal 301 from a temperature sensor which detects a temperature of cooling water for a fuel cell 200, a signal 302 from a sensor that detects a position of an accelerator of the automobile, and a signal 303 corresponding to the vehicle's speed. (See Yamanashi, page 11, lines 6-12.) In this embodiment, Yamanashi does not describe decreasing generated electric power "at a first rate within a predetermined first limit while the temperature of the fuel processor is rising" (emphasis added). Further, Yamanashi does not does not describe decreasing generated electric power "at a second rate having no predetermined limit while the temperature of the fuel processor is not rising" (emphasis added). Yamanashi simply does not disclose first and second rates for decreasing generated electric power in this first embodiment. Yamanashi also does not disclose these rates in the fifth through eighth embodiments described therein. (See Yamanashi, page 16, lines 19-

25; page 18, lines 4-18; page 19, lines 15-35; and page 20, line 23 - page 21, line 8.)
Thus, Applicants respectfully assert that Yamanashi does not disclose or suggest the above-quoted features of claim 3 relating to first and second rates.

The Office Action admits that Yamanashi does not disclose the features of claim 3 relating to decreasing the electric power depending on a change in the temperature of the fuel processor. (See Office Action, page 7, lines 7-13.) The Office Action cites to Nomura as disclosing these features. Applicants respectfully disagree.

The portion of Nomura cited in the Office Action describes a temperature detecting means 24 that is installed in a deriving conduit or device 41 "downstream of the reforming section to detect a temperature of the deriving flow path or device." (See Nomura, col. 3, lines 19-23.) (Emphasis added.) As can be seen in FIG. 1 of Nomura, the temperature detecting means 24 detects the temperature of the conduit or device 41 that is downstream from a heat exchanger 7, which is downstream from another heat exchanger 5, which is downstream from a reforming section 4. The heat exchanger 5 cools the reformed gas output by the reforming section 4. (See Nomura, col. 7, lines 8-13.) The heat exchanger 7 cools the reformed gas that passes out of the heat exchanger 5 and through the CO removal section 6. (See Nomura, col. 7, lines 20-26.) The temperature detecting means 24 detects the temperature of gases cooled by the heat exchanger 7; it does not detect the temperature of a fuel processor. Thus, Applicants respectfully assert that the portions of Nomura relied upon in the Office Action do not disclose the above-quoted features of claim 3 relating to decreasing the electric power depending on a change in the temperature of the fuel processor.

The portions of Zur Megede and Keskula relied upon in the Office Action do not provide the material missing from Yamanashi and Nomura. Accordingly, Applicants respectfully assert that claim 3 is not obvious in view of Yamanashi, Nomura, Zur Megede, and Keskula. Withdrawal of the rejection of claim 3 and reconsideration and allowance of the claim are respectfully requested.

2. The Functionality Performed by the "Electric Power Generation Instructing Means" is not Performed by a Human

MTS-3506US

Application No.: 10/500,274
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The Office Action asserts that the "figures provided are merely algorithms, and for example could be performed by a person getting data on a screen and manually operating valves in the correct process manner." (See Office Action, page 3, lines 11-13.) Applicants respectfully disagree.

Applicants direct the Examiner's attention to FIGS. 1 and 4 of the application and the description of these figures. FIG. 1 illustrates various components of a "fuel cell electricity-generating **device.**" (See Application, page 13, line 24 - page 14, line 9.) (Emphasis added.) One of these components is an "electric power generation instructing means 5," which performs the features of the algorithm in FIG. 4 of the application. (See Application, page 13, line 24 - page 14, line 9 and page 22, line 10 et seq.) One of ordinary skill in the art would understand that the "electric power generation instructing means" is not a person as a **person is not part of a "device."** One of ordinary skill in the art, therefore, would understand that the steps of the algorithm in FIG. 4 are not performed by a person, as the Office Action argues.

Applicants also direct the Examiner's attention to the preamble of claim 3. The preamble recites that the claim is directed to a "fuel cell electricity-generating device." (Emphasis added.) The claim recites various components of the "device," including "an electric power generation instructing means." The claim recites features relating to the "electric power generation instructing means." Again, one of ordinary skill in the art would understand that the "electric power generation instructing means" is not a person as a person is not part of a "device" and that features of the "electric power generation instructing means" are not performed by a person. In re Bernhart, 417 F.2d 1395 (C.C.P.A. 1969) supports such an interpretation. Favorable consideration is respectfully requested.

The Claims Do Not Merely Recite an Intended Use of the "Electric Power Generation Instructing Means"

In a prior Office Action (see Office Action dated May 6, 2008), the Office provided the following remarks:

Applicant's arguments with respect to the independent and dependent claims are all directed to the fact that Yamanashi et al. does not teach a fuel cell

electricity-generating device with elements that are 'configured' to perform certain actions (i.e. decreasing the electric power generated depending on a decrease of load power to be supplied by the fuel cell (see p 8 of the remarks), [sic] etc.). Namely, Applicant argues that using 'configured for' affects the claims in such a manner such that the actions that it is configured for is not functional language. (See Office Action, May 6, 2008, page 9, Item 3.) (Emphasis added.)

The Office Action continues by arguing that Applicants apply "too narrow of a definition to 'configured for' language." (See Office Action, May 6, 2008, page 9, Item 3.) The Office Action argues that the fuel cell system of Yamanashi "is configured for performing the same actions [as Applicants' claimed invention] as it is structurally the same." (See Office Action, May 6, page 9, Item 3.) Applicants respectfully disagree.

By the present Amendment, Applicants amend the claims to recite "configured to" rather than re-introducing the language, "configured for," submitted in a previous Amendment. Applicants respectfully assert that "configured to" provides a structural difference over Yamanashi.

Random House Webster's Unabridged Dictionary (2nd Edition, 1997) (copy enclosed) defines "configure" as "to design or adapt to form a specific configuration or for some specific purpose" and "configuration" as "the relative disposition or arrangement of the parts or elements of a thing." So defined, "configure" relates to a designed relative disposition or arrangement of parts of a thing. This definition does not evoke an intended use, but instead a structural relationship. Thus, by including the recitation of "configured to" in the claims, the claims recite arrangements of parts of a thing in the "electric power generation instructing means," i.e., they recite structure. Because the control unit 300 in Yamanashi does not include such structure, as discussed above, it does not disclose all of the features of the "electric power generation instructing means" recited in claim 3.

Further, even if one were to interpret the claim language "configured to" as being functional language, an interpretation which Applicants dispute, Section

2173.05(g) of the MPEP (entitled "Functional Limitations") provides that functional language is not necessarily improper:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

Accordingly, Applicants respectfully assert that the claims recite patentable differences over Yamanashi and the other references relied upon in the Office Action mailed Sept. 24, 2008, as discussed above.

#### New Claim 14

By the present amendment, Applicants submit a new claim 14 for consideration. For reasons similar to those presented above, Applicants respectfully assert that the references relied upon in the rejection of claim 3 do not disclose or suggest all of the features of claim 14 or claims 4-9 depending therefrom, particularly those relating to the "first power limitation mode" and the "second power limitation mode." Favorable consideration is respectfully requested.

Application No.: 10/500,274 Amendment Dated: January 22, 2009

Reply to Office Action of: September 24, 2008

#### Conclusion

In view of the foregoing remarks and amendments, Applicants respectfully assert that the claims are in condition for allowance and respectfully request early notification to that effect.

Respectfully/submitted,

Allan Ratner, Reg. No. 19,717 Attorney for Applicants

MTS-3506US

Enclosure: Copy of Selection from Random House Webster's

Unabridged Dictionary (2nd Edition, 1997)

PZ/nm

Dated: January 22, 2009

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# RANDOM HOUSE WEBSTER'S UNABRIDGED DICTIONARY

Second Edition



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greater part of the seat by an armrest. Also, confidente.

[ F, special use of confidente female confident] con-fi-den-tial (kon/fi den/shəl), adj. 1. spoken con-fi-den-tial (con-fi den-shal), adj. 1. spoken, a con-fidential remark. 2. Indicating confidence or intimacy, imparting private matters: a confidential cone of intimacy, imparting private matters: a confidential cone of with service or private affairs: a confidential contrary. 4. fcf information, a document, stcl. 3. bearing the class and below service. b. limited to persona authorised to an all below service. b. limited to persona authorised to the confidential contrary. 4. fcf. information, and the contrary of the c

con/fi-den/tial-ly, adv.
—Syn. 1. restricted, private. 2. intimate, familiar. 3.
rusted, trustworthy, private. See familiar.

confidential communication. Law a confidential statement made to a lawyer, doctor, or pastor, or to one's husband or wife, privileged against disclosure in court if the privilege is claimed by the client, patient, penitent, or spouse. Also called privileged com tion. [1790-1800]

con-fid-ing (kan fi'ding), adj. trustful; credulous unsuspicious: a confiding nature. [1635-45; convide -1No<sup>2</sup>] —con-fid'ing-ly, adv. —con-fid'ing-ness, n. con-fig-u-rate (kon fig'yo rat'), v.t., -rat-ed, -rat-ing to give a configuration, form, or design to. [by back formation from configuration]

con-fig-u-ra-tion (ken fig/ye ra/shen), n. 1. the rela-

confligavira-tion (ten figty» nr/shm), n. 1. the rela-tive disposition or errangement of the parts or elements in the disposition of errangement of the parts or elements formation. 3. Astron. a. the relative position or aspect of haveing bodies. b. a group of storn. 4. Chem. as the property of the parts of the parts of the parts of the bonding in a molecule and that enanch be altered without breaking bonds (contrased with conformation). 5. property of the parts of the parts of the parts of the contested to it. A common microcomputer configuration of the parts of the gravity, equiv to L. configuration happed like its model, provided the parts of the part

con-fig-u-ra-tion-ism (ken fig/ye ra/she niz/em), n.
See Gestait psychology. [1920-25; configuration +
-ism] —con-fig/u-ra/tion-ist, n.

int computer. [back formation from consensus, artistly confine from 1.2, 8, 6 worf in for 3.4, 1. 4 worf in for 3.4, 2. 5 worf in for 5.4, 2. 5 word for 5.4 worf in formation for the report. Confine your efforts on fundamental for the report. Confine your efforts on fundamental for the report confine for the power of the formation for the report for formation for the formation for the

—ayn. 1. circumsense. —ant. 1, 2. free.

con-fined (ken find/), adj. 1. limited or restricted. 2.

unable to leave a piace because of iliness, imprisonment,

etc. 3. being in childbirth; being in perturition. [con
FINE + : En'] —con-fin-ed-by (ken fi/mid lê, -find/lê),

adu —con-fin-ed-ness.

COn-fin-ee (kan fi ne', -fi'ne), n. a person held in confinement. [CONFINE + -EE]

confinement. [CONFINE + -KE]

CON-fine-ment (ken infmont), n. 1. the act of confining. 2. the state of being confined. 3. the lying-in of a woman in childbert, accouchement; childbirth. 4. Mil. incarceration in a guardhouse or prison while awaiting trial or as a punishment (distinguished from arrest). [1640-50; CONFINE + -MENT; cf. F confinement] con-firm (kan fürm'), v.t. 1, to establish the truth, ac-

con-time New Yurn'), at 3. to establish the truth, no-currey, validity, or genutioness of comboarts verify. This report confirms my nappions, 2. to acknowledge report confirms my nappions, 2. to acknowledge report confirms to make valid or binding by some forms, or make valid to the confirm to the superior Court. 4. to make firms or nor firm, add streamly, to settle or estab-tion of the confirms of the superior Court. 4. to make firms or norm firm, add streamly, to settle or estab-tions, position, exc. The excellent confirmation to the confirmation to [1200–1300]. < 1. confirmation to confirmation to [1200–1300]. < 1. confirmation to confirm to the confirmation of the confirmation to (1900–1300). < 1. confirmation to confirm to the confirmation to the confirmation to (1900–1300). < 1. confirmation to confirm to the confirmation to the confirmation to (1900–1300). < 1. confir

Syn. 1. prove, substantiate, authenticate, validate 4. fix. —Ant. 1. disprove. 3. invalidate. 4. shake. con-fir-mand (kon'for mand', kon'for mand'), n. a candidate for or recipient of religious confirmation.

adv

concise firmotooy key: < descended or borrowed from; whence b, blend of, blended; c, cognate with; d', compare, deriv, derivative equiv, equivalent; innit, innitative; obl., obleque r., ro-plosing, s, stem; es, spelling, spelled, resp., respelling, respelled, trans, translation; d', orgin unicown; unattested; c, probably earlier than. See the till key irride the front open.

[1880-85; < L confirmandus to be confirmed, ger. of

confirmate to constraint Confirmate to constraint of confirmation (see for markshan), a. 1, the set of confirmate. The sites of confirmation of the confirmation of th

11276-1325; ME < L confirmation - a of confirmatio; See CONFIRM, -ATION] - confirmation-al, adj. CONFIRM-a-to-ry (ken fürms tör'δ, -tör'δ), adj. serving to confirm; corroborative. Also, con-firm'a-tive. [1630-40, < ML confirmatörius, equiv. to L confirmati(re) (see CONFIRM) + -törius - τοκι')

(see constraind + -forlus - rows\*)

on-firmed (for formed), od, 1. made certain as to
con-firmed (for formed), od, 1. made certain as to
con-firmed (for formed), od, 1. made certain as to
ports of new fighting at the front, confirmed recercation
on the three oblock fight to Domes. 2. acticle, radified,
a confirmed backelor. 4, given additional determination made resolute. 8, laying received the religious rate
for made resolute. 8, laying received the religious rate
rate, 227 — con-firme-ed-by (lent flut\*mid 18), odd
rates, 227 — con-firme-ed-by (lent flut\*mid 18), odd
rates, 227 — con-firme-ed-by (lent flut\*mid 18), odd
rates, 227 — con-firme-ed-by (lent flut\*mid 18), odd con-fis-ca-ble (kan fis/ka bal, kon/fa ska bal), adj. able to be confiscated. [1720-30; confiscate) + -A

able to be confinedated. [1703–36; conventions] \*\* nature] confinedate (hour's skit), he for [vist), us, -cated, hour's skit, he hour's have been defeated and the confinedate of the confinedate of the confinedate properties, by way of penalty, for public uses 2. to seize by or set if by sathority; appropriate sammended of the confinedate of the confined

con-fis-ca-to-ry (ken fis/ke tôr/e, -tōr/e), adj. cher-acterized by, effecting, or resulting in confiscation. [1790-1800; CONFISCATE + -ONY']

CON-fit (kön fê'), n. French Cookery. duck or goose cooked in its own fat and preserved. [ < F; see COMPIT] Con-fit-e-or (ken fit's or'), n. Rom. Cath. Ch. a prayer in the form of a general confession said at the beginning of the Mass and on certain other occasions. [1150-1200, ME: after first word of Latin prayer: I con-

COn-fi-ture (kon/fi chōōr/), n. a confection; a preserve, as of fruit. [1350-1400; ME < MF. See comput. - URE]

con-fla-grant (kon fla/grant), adj. blazing burni on fire. [1650-60; < L conflagrant (s. of conflagrat prp. of conflagrare. See conflagration, ant] prp. of conflagrare. See CONFLAGRATION, -ANT]

Conflagration (kon'fig gra'ainn), n. a destructive fire, usually an extensive one. [1545-55; X L conflagrationtion-(s. of conflagratio), equive to conflagratius) pip. of conflagratire to burn up (con. con. + flagr. (akin to fulgur lightning, flammar FLAME, GR. philox, see PHLOX) +
-dius. -ATE') + -ion. -ion! —con'fla-gra'tive, adj.

—Syn. See Hama.

con-flate (ken flat/), v.t., -flat-ed, -flat-ing. into one entity; merge: to conflate dissenting votes into one protest. [1600-10; < L conflatus, ptp. of conflate to fuse together, equiv. to con- CON- + flare to BLOW<sup>2</sup>]

Con-flation (so flat'shen), n. 1. the process or result of fusing items into one entity fusion; amaigamation. 2. Bibliog. a. the combination of two variant texts into a new one. b. the bext resulting from such a combination. [1400-50] late ME < LL conflatio, See convict.r., 1001] con-flict in ken flikt'r. In ken'flikth, i.s. 1. to contain the collision of subgreeness the condictory, a visit in collision of subgreeness the condictory, a visit in collision of subgreeness conflicted with that of the coller, they can be considered to the collision of the collection of the collision of the con-flict (v. ken flikt'; n. kon'flikt), v.i. 1, to co

con-flict-ed (kan flik/tid), adj. full of conflicting emotions or impulses: a situation that makes one feel very conflicted. [CONPLICT + -ED<sup>2</sup>]

con-flict-ing (ken flik/ting), adj. being in conflict or diangreement; not compatible: conflicting viewpoints. [1600-10; conflict + -ino<sup>2</sup>] —con-flict/ing-ty, adv. [1800-19, conflict | -1807] — con-flict | -1807] —

ties, interests, etc., can be advanced only at the expens of another of them. [1950-55] con'flict of laws', 1. dissimilarity or discrepancy be-tween the laws of different legal orders, such as states or nations, with regard to the applicable legal rules and principles in a matter that each leg regulate. 2. Also called private inte-branch of law dealing with the deterr branch of law dealing with the detery applicable to a private-law matter, having jurisdiction to adjudicate such the extent to which an adjudication in another legal order is to be recognize

con-flu-ence (kon/floo ans), con-fluence (kon/floo ana), n. 1.
of two or more streams, rivers, or the receivers, or the mission and Mississips of the Mission and Mississips of the Mississips of the flowing together of two rivers, or the like. 4. a coming to things concourse. 5. a crowd or t. Alao, con-flux (kon/fluxs), 1375—146.

L. con/fluxnin, and confluence of the mississips of — Syn. 4. union, joining, meeting.

Con-fluent (konfifos ont), adj. 1.
together; blending into one confluentidas. 2. Pothol. a. running to
efflorescences. b. characterized by
cences: confluent smallpox. — n. 3. c.
confluent stream. 4. a tributary stre
ble (\* MF) < L. confluent; 6. of confluent to flow openions. A confluentidation of the confluentidation of the confluence to flow openions. A confluence to flow openions.

con-fo-cal (kon fo/kal), adj. Math. focus or foci. [1865-70; con- + rocs ocus or toci. [1885-70; CON + roca Con-form (ksa form²), wî. 1. to so harmony; comply (usually fol. by 10): 1. 2. to act in accord with the prevail tudes, practices, etc., of society or a conform in order to succeed in this conform in order to succeed in this conform in the conform in the conformation of the conformation of

6. to make similar in form, nature, obring into agreement, corresponde—cdi, 8. Archaic conformable, [12 fo(u)rmen < AF, MF conformer < shape. See con., rorm]—con-for form/ingly, adu.

—Syn, 1. yield, agree, consent. 3. tally. 7. adapt, adjust, accommodat dissent. 3. differ.

con-form-a-ble (kan för/ma bal), CONFORM.-Able (ken för/ms bel), a ing in form, nature, or character; sim obedient; submissive: a conformable Geol. of or pertaining to an unbroken or beds, characteristic of uninterrupi in under unconformable. [1425-CONFORM.-ABLE]

con-for-mal (ken för/mel), adj. noting a map or transformation scale are preserved. [1640-50; < same shape. See con-, FORMAL<sup>1</sup>]

confor/mal projec/tion. Cartog. in which engles formed by lines are made using this projection preserves small area. Also called orthomorphic con-form-ance (ken for/mans), a forming; conformity. [1600-10; conre con-for-ma-tion (kon/for ma/shan)

CON-for-ma-tion (kon-for-ma'-thon) formation, structure; form as of a reformation, and act or process of conforming; adequate act or process of conformation; adequate structure about a result from actions about single bonds within an action at the structure of the structure of conformation (a conformation), equive, to conformation of conformation of conformation, and the structure of conformation hope. con-form-ist (ken for/mist). forms, esp. unquestioningly, to the standards of a group, society, etc. 2. son who conforms to the usages of an esp. the Church of England. —adj.

esp. the Church of Enginessized by conforming, esp. in action or a 35: conform + ist] —conform/ist 35; CONFORM + 18T] — CONTORM\*18T in accord with prevailing social sit practices, etc. 2. correspondence in character; agreement, congruity, of compliance or acquiseence; obedienc compliance with the usages of an east, the control of the esp. the Church of England, 5. Geo between adjacent conformable strata. (def 2a). [1375-1425; late ME conformation conformitas. See CONFORM, -177]

conformities. See CONFORM. - ITY]
CON-found (kon found', ken: for found'), w.t. 1. to perplex or amaze, disturbance or surprise; bewilder, cot coted directions confounded him. 2. fusion or disorder: The recolution com; 3. to throw into increased confusion. 3. to throw into increased contusion treat or regard erroneously as identic by mistake: truth confounded with e so that the elements cannot be distincted 6. to damn fused in mild impre til 7. to contradict or refute to contradict or refute. So to put to shame, the so to be a solid to shame, the solid to be solid to shame, the solid to be solid to shame, the solid to shame the solid to shame, the solid to shame, the solid to shame, the solid to shame, the solid to shame the sham

quiv. to con- con- + fundere to pour ele, ad) —con-found'er, n —con-—Syn. 1. dumbfound, daze, nonplus 

con-fra-ter-ni-ty (kon/fra tůr/ni të